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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,206	02/20/2004	Seth A. Darst	IPT-012.02	6690

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EXAMINER

KIM, ALEXANDER D

ART UNIT PAPER NUMBER

1656

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/783,206

Applicant(s)

DARST ET AL.

Examiner

Alexander D. Kim

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Application Status***

1. By virtue of a preliminary amendment filed on 11/12/2004, claims 31-49 have been added. Thus, claims 1-49 are pending in the instant case.

### ***Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, 21-23, 31-43 and 44-49, drawn to a crystal of a modulator bound to a core RNA polymerase and a method of making the RNA polymerase crystal, classified in class 530, subclass 350.
  - II. Claims 9-20 and 24-29, drawn to a method of identifying an inhibitor agent for bacterial RNA polymerase or inhibits bacterial growth, classified in class 703, subclass 11.
  - III. Claim 30, drawn to a computer having a representation of rifampicin bound to the core RNA polymerase (Rif-RNAP) or a portion of (Rif-RNAP), classified in class 345, subclass 419.
3. The inventions are distinct, each from the other because of the following reasons:

Group I are related to Group II by virtue of the protein crystal of Group I is used to obtain structural data which is used in the methods of Group II. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as

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claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, Group I is mutually exclusive and not obvious variants from Group II because Group I is a protein crystal and a method of making said crystal and Group II is a method of using data which does not require to use the protein crystal of Group I. Because methods of Group II require a data and not actual protein of Group I, they are not capable of use together. The crystal of Group I is used to obtain three-dimensional structural data and a method of Group II is used to find potential inhibitor for the protein *in silico*, thus each Group has distinct operation and function.

Because these inventions are distinct for the reasons given above, because the inventions have acquired a separate status in the art as shown by their different classification, and because the search required for any one Group is not required for the other Group as each Group requires a different non-patent literature search using different keywords due to each Group comprising different products and/or method steps, restriction for examination purposes as indicated is proper.

Groups I and III are related to each other by the virtue of a Group I co-crystal of Rif-RNAP structure can be displayed in computer of Group III. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, each

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product of Group I and IV are mutually exclusive and not obvious variant to each other because each product from Groups I and III is chemically distinct from each other.

Group I contains a polypeptide with small organic compound whereas Group III is a computer comprising a wholly different material. Crystal of Group I is used to obtain structural data in X-ray crystallography and Group III use a structural data to show the structure of a protein. Thus Group I and III have different function from each other as described above.

Because these inventions are distinct for the reasons given above, because the inventions have acquired a separate status in the art as shown by their different classification, and because the search required for any one Group is not required for the other Group as each Group requires a different non-patent literature search using different keywords due to each Group comprising different products and/or method steps, restriction for examination purposes as indicated is proper.

Group II and Group III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the product as claimed can be used in a materially different process of using that product. The computer of Group III can be used to generate ribbon diagram of protein crystal, for example.

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Because these inventions are distinct for the reasons given above, because the inventions have acquired a separate status in the art as shown by their different classification, and because the search required for any one Group is not required for the other Group as each Group requires a different non-patent literature search using different keywords due to each Group comprising different products and/or method steps, restriction for examination purposes as indicated is proper.

#### ***Notice of Possible Rejoinder***

4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

**Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander D. Kim whose telephone number is (571) 272-5266. The examiner can normally be reached on 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached on (571) 272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alexander Kim  
Date

September 27, 2006

  
KATHLEEN M. KERR, PH.D.  
SUPERVISORY PATENT EXAMINER